

Application No.: 09/299,596  
Art Unit 3624  
Reply filed: August 18, 2004  
Page 2

Attorney Docket No. 0630-0913P  
Office Action date: May 20, 2004

### **REMARKS**

Applicant thanks the Examiner for the very thorough consideration given the present application.

Claims 3-33 are now present in this application. Claims 3, 10, 16, 17, 23, 26 and 27 are independent. Reconsideration of this application is respectfully requested.

#### Acknowledgement of IDS Citations

Applicants thank the Examiner for considering three of the references cited in the Information Disclosure Statement filed on August 23, 2001.

However, Applicants ask the Examiner to consider the cited reference (Korean 97-0007003) on the associated PTO-1449 that was not initialed, and provide Applicants with an initialed copy of the IDS for that reference.

Applicants also ask the Examiner to consider the three references supplied with, and cited in, the Information Disclosure Statement filed May 7, 2003, and for providing Applicants with an initialed copy of the PTO-1449 form filed therewith.

Additionally, Applicants respectfully request that the Examiner consider the one reference supplied with, and cited in, the Information Disclosure

Statement filed on July 30, 2004, and to provide Applicants with an initialed copy of the PTO-1449 form filed therewith.

#### Drawings

Applicant acknowledges with appreciation the receipt of the Form PTO-948. Applicant is attaching formal drawings that overcome the objections set forth in the PTO-948.

#### Premature Final Rejection

The Office Action was made final allegedly because "Applicant's amendment necessitated the new ground(s) of rejection . . ."

Applicant respectfully disagrees with this conclusion regarding at least claims 23-25.

In Applicant's February 23, 2004 Amendment, the scope of claims 23-25 was essentially unchanged. The amendments made the claim language more idiomatic. The wording "a first step", "a second step" and "a third step" was deleted because it was merely stating the obvious, i.e., that there were three separate steps recited in the order recited.

These idiomatic and simplification changes did not change the scope of the claims for prior art purposes but merely made them clearer and easier to understand. As such, they cannot serve as the basis to justify making a wholly

different art rejection of the claims without giving Applicant substantive and procedural due process rights to be able to amend and/or provide arguments traversing the new art rejection as a matter of right and to which the Examiner must respond in a subsequent Office Action on the merits.

Accordingly, withdrawal of the finality of the outstanding Office Action is in order and is respectfully requested.

Claim Rejections under 35 U.S.C. §102

Claims 3, 4, 7, 9-14, 16-22 and 26 are rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,536,661 to Takami et al. (hereinafter, "Takami"). Applicant respectfully traverses this rejection and requests reconsideration thereof.

At the outset, Applicant submits that claim 9 cannot be anticipated by Takami, because claim 9 depends from claim 8 (not included in this anticipation rejection, but rather an obviousness rejection, *infra.*). For at least this reason, the rejection is improper and must be withdrawn.

A prior art reference anticipates the subject of a claim when the reference discloses every feature of the claimed invention, either explicitly or inherently (see, *In re Paulsen*, 30 F.3d 1475, 1478, 1479, 31 USPQ2d 1671, 1675 (Fed. Cir. 1994), *In re Spada*, 911 F.2d 705, 708, 15 USPQ2d 1655, 1657 (Fed. Cir. 1990),

Hazani v. Int'l Trade Comm'n, 126 F.3d 1473, 1477, 44 USPQ2d 1358, 1361 (Fed. Cir. 1997) and RCA Corp. v. Applied Digital Data Systems, Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984).

It is well settled that the burden of establishing a *prima facie* case of anticipation resides with the Patent and Trademark Office (PTO). See, In re Piasecki, 745 F.2d 1468, 223 USPQ 785, 788 (Fed. Cir. 1984).

First, the Examiner never points out what language in the 85 or so lines of Takami's text corresponds to each of the four positively recited blocks of claim 3. Applicant is left to guess at what those 85 or so lines of text and all of Figs. 11-15 correspond to.

Applicant respectfully submits that it has been denied fundamental substantive and procedural due process to which it is entitled under the Administrative procedures Act because of this failure to clearly identify the portions of Takami that allegedly anticipate each of the claimed features of the rejected claims. See, in this regard, In re Zurko, 119 S.Ct. 1816, 50 USPQ2d 1930 (1999), and In re Gartside, 53 USPQ2d 1769 (Fed. Cir. 2000).

Accordingly, the rejection is fundamentally flawed and should be withdrawn.

Nevertheless, in an attempt to be fully responsive, Applicant has concluded that the 85 or so lines of Takami, from column 11, line 40 through

column 12, line 58, and Figs. 11-13 do not disclose what is recited in claim 3.

Independent claims 3, 10 and 16 positively recite, among other features, a “radio signal receiving block for . . . determining whether the received signal corresponds to a general information or a balance storing information.”

Takami only discloses balance information once, in col. 7, line 13, and then only in the context of the types of electronic money information stored in electronic money information memory 30 and information processing unit 31 of IC card 1. In regard to balance information, Takami merely discloses that information processing unit 31 is used for controlling “output of the balance.”

Thus the sum total of Takami’s disclosure regarding balance is deminimus.

Takami neither discloses nor suggests any device for “determining whether the received signal corresponds to a general information or a balance storing information.”

The portion of Takami relied upon in the rejection (from column 11, line 40 through column 12, line 58, and Figs. 11-1) does not mention balance information at all, let alone determining whether a received signal corresponds to a general information or a balance storing information.

Although Takami discloses comparing an ID number extracted from a signal with a previously stored ID number, Takami does not disclose performing

the comparison "if it is determined that the received signal corresponds to balance storing information" as recited.

Independent claims 3, 10 and 16 positively recite a specific determination that has to be made and a specific condition that has to be met before a specific comparison is made. Takami utterly fails to disclose these positively recited features of claim 3. In other words, Takami fails to disclose an apparatus that (1) determines whether the received signal corresponds to a general information or a balance information; (2) compares a serial number previously extracted from the received signal with a previously stored serial number; and (3) performs the comparison if the received signal corresponds to balance information.

Accordingly, Takami does not anticipate the apparatus recited in claims 3, 10, 16 and dependent claims 5, 6, 8 and 15.

Further, with respect to claim 4, the Office Action contains no explanation of what part of Takami allegedly discloses where a computation block is designed so that a certain amount of data is stored in the memory block only when first and second balance storing information are received from the radio signal block.

As noted above, Takami only contains a very broad, general disclosure that its information processing unit 31 controls the output of the balance. There is no disclosure in Takami of "first and second balance storing information" being received, as recited, or of an apparatus storing a certain amount of information

in a memory block “only when first and second balance storing information are all received from the radio signal storing block,” as recited. Takami is totally devoid of such features, being limited to just disclosing an information processing unit 31 for controlling output of the balance. Moreover, as noted above, no reference to balance information is made in the referenced column 12, lines 6-58 or in the referenced Figs. 13-15.

Accordingly, Takami does not anticipate claim 4.

Further, with respect to claim 7, Takami does not disclose a unit “for storing balance storing data . . . if the received signal corresponds to balance storing operation,” as recited, or “reading the balance storing data stored in the memory block if money is paid,” as recited. As pointed out above, Takami’s disclosure regarding “balance” is extremely limited. In fact it is limited to disclosing that Takami has an information processing unit 31 for controlling the output of the balance.

The reference in the Office Action to column 11, line 59 to column 12, line 5 is completely devoid of any reference to balance information at all.

Accordingly, Takami does not anticipate claim 7.

Further, with respect to claim 11, the Office Action contains no explanation of what part of Takami allegedly discloses where a computation block is designed so that a certain amount of data is stored in the memory block

only when first and second balance storing information is determined to be proper information. As noted above, Takami only contains a very broad, general disclosure that its information processing unit 31 controls the output of the balance. There is no disclosure in Takami of "first and second balance storing information" being received, as recited, or of an apparatus storing a certain amount of information in a memory block "only when first and second balance storing information are all received from the radio signal storing block," as recited. Takami is totally devoid of such features, being limited to just disclosing an information processing unit 31 for controlling output of the balance. Moreover, no reference to balance information is made in the referenced column 12, lines 15-58.

Accordingly, Takami does not anticipate claim 11.

Further, with respect to claims 12 and 13, Takami only discloses just receiving, but not transferring, money when the ID of the card ID memory 48 in the IC card 47 is different from the ID stored in the ID card memory 27 in the ID card 25. This is completely different from what is recited and has nothing to do with balance information, let alone proper balance information.

Accordingly, Takami does not anticipate claims 12 and 13.

Further, with respect to claim 14, which recites a control means for decrypting a balance storing information, allegedly shown somewhere in the 67



or so lines referenced in the rejection in columns 11 and 12, Applicant respectfully submits that there is no such disclosure in Takami, who does not disclose anything to do with balance information in the referenced text, let alone storing the balance storing information, as recited.

Accordingly, Takami does not anticipate claim 14.

Further, with respect to claim 26, which is allegedly shown somewhere in the referenced 85 or so lines of text in columns 11 and 12, Applicant respectfully submits that Takami only mentions updating the information in its system in col. 7, lines 11-13, where Takami states, “. . . an information processing unit 31 for controlling update of the electronic money information of the electronic money information memory 30 . . .” Nowhere can Applicant find in Takami, a disclosure of “personal information update information,” of “determining whether a received radio signal corresponds to personal information update information,” or of extracting a certain variable if the signal corresponds to such information, or any of the other steps recited in claim 26.

Accordingly, Takami does not anticipate claim 26.

For the aforementioned reasons, Applicants respectfully submit that claims 3, 4, 7, 9-14, 16-22 and 26 are not anticipated by Takami, these rejections, which are based on Takami, are improper, and these rejections should be withdrawn.

Claim Rejections under 35 U.S.C. §103

The Examiner rejects claims 5, 6, 8, 15, 23-25 and 27-33 under 35 USC 103(a) as unpatentable over U.S. Patent 6,311,167 to Takami et al. (hereinafter, "Takami") in view of U.S. Patent 6,105,006 to Davis et al. (hereinafter, "Davis"). This rejection is respectfully traversed,

Initially, Applicant respectfully submits that U.S. Patent 6,311,167 was not issued to Takami. U.S. Patent 6,311,167 was issued to Davis. It appears that the rejection is primarily based either on a Takami reference that has a different patent number than 6,311,167 or to U.S. Patent 6,311,167 that is issued to Davis.

Applicant respectfully submits that it has been denied fundamental substantive and procedural due process to which it is entitled under the Administrative procedures Act because of this mis-identification of the principal reference on which the rejection is based. See, in this regard, In re Zurko, 119 S.Ct. 1816, 50 USPQ2d 1930 (1999), and In re Gartside, 53 USPQ2d 1769 (Fed. Cir. 2000). Applicant is left to guess at which references are being applied against the claims.

Accordingly, this rejection is fundamentally unsound and must be withdrawn.

Nevertheless, in an attempt to be as fully responsive as possible, Applicant

notes that, with respect to claims 5, 6 and 8, that depend from claim 3, the Takami patent was applied in the rejection of claim 3, from which claims 5, 6 and 8 depend, and that Takami does not disclose or suggest many of the recited features in claims 5, 6 and 8 for the same reasons that claim 3 is not anticipated by Takami.

Moreover, Davis '006 only discloses "balance" in terms of a single sentence that is found in two separate locations in Davis, i.e., in col. 18, lines 34-38, and in col. 19, lines 36-40, which states that Davis' transaction processing system authenticates smart card 920, the requesting party's financial status (e.g., account balance, credit availability, etc.) and either completes or denies the transaction.

So, even if these two references were properly combined (which they are not for reasons stated below), they would not result in, or render obvious, the claimed invention recited in claims 5, 6 and 8.

In rejecting claims under 35 U.S.C. 103, it is incumbent on the Examiner to establish a factual basis to support the legal conclusion of obviousness. See, In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the Examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one of ordinary skill in the pertinent art would

have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal Inc. v. F-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the Examiner are an essential part of complying with the burden of presenting a *prima facie* case of obviousness. Note, In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. In re Eritch, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992). To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be suggested or taught by the prior art. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1970). All words in a claim must be considered in judging the patentability of that claim against the prior art. In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

A showing of a suggestion, teaching, or motivation to combine the prior art references is an "essential evidentiary component of an obviousness holding." C.R. Bard, Inc. v. M3 Sys. Inc., 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998). This showing must be clear and particular, and broad conclusory statements about the teaching of multiple references, standing alone, are not "evidence." See In re Dembiczak, 175 F.3d 994 at 1000, 50 USPQ2d 1614 at 1617 (Fed. Cir. 1999).

The alleged reason for combining Takami and Davis '006 is because both Takami and Davis teach storing electronic money with the use of radio frequency and comparing pertinent encrypted data to complete transactions.

Applicant respectfully submits that this showing of motivation is neither clear nor particular but is the type of broad, conclusory statement of both references that, standing alone, are not proper evidence of proper motivation to combine these references as suggested. Compare, Dembiczak, cited above.

Accordingly, the Examiner has not made out a *prima facie* case of proper motivation to combine the references or a *prima facie* case of obviousness of the claimed invention.

Moreover, if the rejection is based on both Davis '167 and Davis '006, Applicant respectfully notes that those two patents contain the same disclosure regarding balance information, which is very sparse. In fact, both Davis patents

only disclose "balance" in terms of a single sentence that is found in two separate locations in Davis, i.e., in col. 18, lines 34-38, and in col. 19, lines 36-40, which state that Davis' transaction processing system authenticates smart card 920, the requesting party's financial status (e.g., account balance, credit availability, etc.) and either completes or denies the transaction.

Combining these two disclosures will not result in the invention recited in claims 5, 6 and 8 just as combining Davis and Takami will not result in the particular balance features recited in those claims (as well as in claim 3, which is discussed above).

Reconsideration and withdrawal of this rejection of claims 5, 6 and 8 are respectfully requested.

Further, with respect to claim 15, Applicant notes that claim 15 is not taught by Takami for the same reasons that claim 10, from which these claims depend, is not taught by Takami.

Moreover, Davis '006 only discloses "balance" in terms of a single sentence that is found in two separate locations in Davis, i.e., in col. 18, lines 34-38, and in col. 19, lines 36-40, which states that Davis' transaction processing system authenticates smart card 920, the requesting party's financial status (e.g., account balance, credit availability, etc.) and either completes or denies the transaction.

So, even if these two references (Takami (???) and Davis '006) were properly combined (which they are not for reasons stated below), they would not result in, or render obvious, the claimed invention recited in claim 15.

Moreover, for reasons stated above, Applicant respectfully submits that the Examiner has not made out a *prima facie* case of proper motivation to combine the references or a *prima facie* case of obviousness of the claimed invention.

Moreover, if the rejection is based on both Davis '167 and Davis '006, Applicant respectfully notes that those two patents contain the same disclosure regarding balance information, which is very sparse. In fact, both Davis patents only disclose "balance" in terms of a single sentence that is found in two separate locations in Davis, i.e., in col. 18, lines 34-38, and in col. 19, lines 36-40, which state that Davis' transaction processing system authenticates smart card 920, the requesting party's financial status (e.g., account balance, credit availability, etc.) and either completes or denies the transaction.

Combining these two disclosures will not result in the invention recited in claim 15 just as combining Davis and Takami will not result in the particular balance features recited in those claims.

Reconsideration and withdrawal of this rejection of claim 15 is respectfully requested.

With respect to claims 23-25, neither Takami nor Davis '006 disclose the claimed invention. Davis comes closest by disclosing that its transaction processing system authenticates the smart card 920, the requesting party's financial status (such as its account balance, etc.) and either completes or denies the transaction. Takami does not even disclose this feature but is limited to the meager disclosure of balance in col. 7, as noted above.

Neither Takami nor either cited Davis patent discloses determining whether there is no balance storing information and releasing a card service stop if extracted certification information is the same as previously stored certification information, as recited in claims 23-25.

Accordingly, even if these references were somehow combined, they would not result in, or render obvious, the claimed invention.

Moreover, the Examiner does not make out a *prima facie* case of proper motivation to combine the applied references for the reason stated above regarding the same reference combinations.

Accordingly, the Examiner does not make out a *prima facie* case of obviousness of the claimed invention recited in claims 23-25.

Reconsideration and withdrawal of this rejection of claims 23-25 are respectfully requested.



With respect to claims 27-33, those claims recite method steps corresponding to many of the apparatus features recited in claims 3, 10 and 16, features which clearly are missing from Takami and both Davis references for reasons discussed above.

Neither Takami nor either cited Davis patent discloses determining whether there is no balance storing information, and releasing a card service stop if extracted certification information is the same as previously stored certification information, as recited in claims 27-33.

Moreover, the Examiner does not make out a *prima facie* case of proper motivation to combine the applied references for the reason stated above regarding the same reference combinations.

Accordingly, the Examiner does not make out a *prima facie* case of obviousness of the claimed invention recited in claims 27-33.

For at least the foregoing reasons, it is respectfully submitted that all pending claims are allowable over the applied art, difficult as that is to determine regarding the rejection of claims 5, 6, 8, 15, 23-25 and 27-33. Accordingly, all claims should be allowed.

Application No.: 09/299,596  
Art Unit 3624  
Reply filed: August 18, 2004  
Page 19

Attorney Docket No. 0630-0913P  
Office Action date: May 20, 2004

**CONCLUSION**

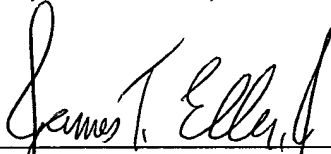
The stated grounds of rejection have been properly traversed, accommodated, or rendered moot. It is believed that a full and complete response has been made to the outstanding Office Action, and that the present application is in condition for allowance.


However, if there are any outstanding issues, the Examiner is invited to telephone Bob Webster, Reg. No. 46,472, at 703-205-8000, in an effort to expedite prosecution.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§1.16 or 1.17, particularly extension of time fees.

Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

By:   
James T. Eller, Jr.  
Reg. No. 39,538

0630-0913P  
JTE/RJW/adf/te   
Attachment:

P. O. Box 747  
Falls Church, VA 22040-0747  
(703) 205-8000  
Formal Drawings